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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,053	07/11/2003	Makoto Nonoyama	240071US3	3048

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EXAMINER

RACHUBA, MAURINA T

ART UNIT PAPER NUMBER

3723

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/617,053

Applicant(s)

NONOYAMA ET AL.

Examiner

M Rachuba

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, and 5 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hykes et al, US005975995A, cited in "Notice of References Cited" mailed 28 March 2004. Please refer to figures 4-7 and column 5 lines 44 through column 6, lines 56. '995 discloses a grinding method comprising the steps of: providing a plurality of grinding wheels **152, 162**; selecting a predetermined grinding wheel (either **152, 162**) from the plurality of grinding wheels; simultaneously grinding plural grinding portions of a workpiece using plural grinding wheels (figure 5); wherein the step of selecting a predetermined grinding wheel from the plurality of grinding wheels is performed prior to the step of simultaneously grinding plural grinding portions of a workpiece using the plural grinding wheels (figure 4); individually controlling, via controller **42**, each of the grinding wheels during the grinding step; and controlling the grinding step such that grinding by the predetermined grinding wheel is terminated prior to a termination of grinding by the other grinding wheel (figure 7).

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hykes et al, '995 in view of EP1088621 A2. '995 does not disclose that a grinding condition of the each grinding portion by the each grinding wheel is changed according to a result of measuring the grinding portions; or that each grinding step by each grinding wheel has plural grinding portions of different velocity of a grinding feed; and a removable amount of the grinding portion by the predetermined grinding wheel is set less than a removable amount of the grinding portion by the other grinding wheel in a slower grinding feed velocity portion of the grinding step. '621, teaches that each grinding portion is ground by each grinding wheel according to its gauged or measured diameter. Further, '621 teaches each grinding wheel has plural grinding portions of different velocity of a grinding feed (interpreted as each grinding wheel, dependent on the type of grinding, rough or finish, has a different feed velocity), and that the amount of material to be removed by one grinding wheel is less than that by the other, inherent when finish grinding follows rough grinding. It would have been obvious to one of ordinary skill in the art to have provided '995 with a step of a grinding condition of the each grinding portion by the each grinding wheel is changed according to a result of measuring the grinding portions, as taught by '621, abstract, to ensure accurate grinding by the device. Further, it would have been obvious to one of ordinary skill in the art to have provided '955 with grinding wheels have plural grinding portions of different velocity of a grinding feed (interpreted as each grinding wheel, dependent on the type of grinding, rough or finish, has a different in-feed velocity), and that the amount of material to be removed by one grinding wheel is less than that by the other, as taught

by '621, column 8, lines 52 through column 9, lines 24, to prevent over-grinding, and damage to the workpiece.

***Allowable Subject Matter***

5. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment has overcome the rejection based on 35 USC 112 and 102(b) over EP 1008621 A2. However, the claims now read on Hykes et al, US005975995A, alone or in combination with '621.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

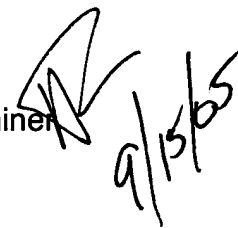
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is 571-272-4493. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Rachuba  
Primary Examiner  
Art Unit 3723

Handwritten signature of M. Rachuba and the date 9/15/05.